

REMARKS

Claims 1-30 are pending. By this amendment, claims 1, 7 and 25 are amended. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

M.P.E.P. §707.02 states:

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.

M.P.E.P. §707.02 also states:

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner.

The instant application was filed September 18, 2001, and has been pending for more than seven years. It is also respectfully noted that the instant application has been the subject of five Office Actions on the merits.

Applicant respectfully requests that the instant application be considered "special" and be advanced out of turn for further action as set forth in M.P.E.P. §708.01.

M.P.E.P. §707.07(f) states:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

In the response filed January 17, 2007, Applicant traversed the rejections under 35 U.S.C. §§102(b) and 103(a) over Miller (U.S. Patent 5,272,285) on numerous grounds. For example, on page 10 of the January 17, 2007 response, Applicant argued that Miller does not disclose or

suggest a thin flexible enclosure as recited in claims 1, 9 and 18 or a flexible bag-like plastic material enclosure as recited in claim 11. Applicant further argued that Miller does not disclose or suggest a noise suppressing member consisting essentially of a thin flexible enclosure, as recited in claim 27.

With respect to claim 9, Applicant argued on page 11 of the January 17, 2007 response that Miller does not disclose or suggest, at least, assembling an apparatus for supplying breathable gas. As another example, on page 12 of the January 17, 2007 response, Applicant specifically traversed the examiner's reliance on the rationale used by the court in the decision of Nerwin v. Erlichman, 168 USPQ 177 (BPAI 1969).

It is respectfully noted that the examiner repeats the rejections under 35 U.S.C. §§102(b) and 103(a), and the reliance on case law rationale, but does not answer the substance of any of the arguments presented in the January 17, 2007 response.

In the event that the examiner repeats the rejections in response to the instant filing, the examiner is respectfully requested to comply with the requirements of M.P.E.P. §707.07(f) and answer the substance of the arguments presented in the January 17, 2007 response and the instant response.

Claims 1, 2, 4-7, 9, 10 and 27-30 were rejected under 35 U.S.C. §102(b) over Miller. The rejection is respectfully traversed.

Claim 1 recites an apparatus for supplying breathable gas including a relatively rigid external housing, at least one noise producing component internal to the housing, the at least one noise producing component including an electric motor blower and at least a first muffler, and a thin flexible enclosure substantially sealed around the at least one noise producing component and sealed to the at least one noise producing component at at least one location.

The standard of anticipation is identify of invention. In other words, the prior art must disclose the identical invention recited in the claims. See, for example, M.P.E.P. §2131, which states:

The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Office Action on page 2, paragraph number 3, alleges that Miller discloses an electric motor blower as “compressors are known to be run by electricity to power a motor producing air.” However, as noted in the reply filed January 17, 2007, the examiner does not provide any substantial evidence in support of this finding. While it is possible that the examiner is relying on the theory of inherency for this finding, it is respectfully noted that the examiner has not satisfied the requirement of providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Miller, as required by M.P.E.P. §2112.

Furthermore, while it is possible that the examiner is taking Official Notice that compressors are known to be run by electricity to power a motor producing air, it is respectfully noted that the examiner has not provided any documentary evidence in support of this finding as required by M.P.E.P. §2144.03(C). It is also respectfully noted that Applicant requested, on page 11 of the January 17, 2007 response, that the examiner identify those portions of Miller that are regarded as disclosing or suggesting the use of an electric blower motor, or to identify any known prior art so that Applicant may assess the undisclosed prior art and determine whether it is in fact combinable with the teachings of Miller.

The Office Action on page 2, paragraph number 3, also alleges that Miller discloses at least one muffler, allegedly corresponding to a reduced size of the inlet and outlet (32 and 35) of

Miller which would theoretically lessen the sound of rushing air entering or exiting the inlet or outlet.

As shown on page 3 of the Office Action, the compressor line 35 of Miller is identified as allegedly corresponding to the at least a first muffler of claim 1. It is respectfully submitted that the examiner has failed to establish that the compressor line corresponds to the first muffler of claim 1.

Miller disclose in column 4, lines 40-44, that an aperture 34 can be provided through a base portion of one or both of the trays 20, 21 to permit passage of a compressor line 35 therethrough as needed. Miller disclose in column 4, lines 36-40, that the flanges 22a, 23a and 22b, 23b can be molded or otherwise formed to provide for access openings 30 between opposing pairs when closed to allow inlet and/or outlet lines 32 to or from the compressor 12 to pass through.

There is no disclosure or suggestion by Miller that either the inlet and/or outlet lines 32 or the compressor line 35 correspond to a muffler. In other words, there is no disclosure or suggestion by Miller that would support the examiner's conclusion that the alleged reduced size of the inlet and/or outlet 32 or the compressor line 35 would lessen the sound of rushing air entering or exiting the inlet or outlet. Furthermore, it is respectfully noted that there is no disclosure that the compressor of Miller is used, or intended to be used, as an air compressor. Compressors have applicable uses in fields beyond air compression. For example, compressors are used in refrigeration units to compress a refrigerant.

As there is no disclosure or suggestion by Miller that the compressor is usable for, or even capable of, supplying breathable gas, Miller also fails to anticipate claim 1 which recites an apparatus for supplying breathable gas.

The diagram on page 3 of the Office Action identifies the inner layer 16 of Miller as corresponding to the thin flexible enclosure recited in claim 1. However, as discussed in the reply filed January 17, 2007, the inner layer 16 is constructed of fiberglass or other flexible and suitably sound absorbent material, such as conventional molded plastic foam material like polyurethane, but is attached to the relatively rigid outer layer 14 by glue, pressure sensitive adhesive, or the like. Accordingly, the layer 16 does not correspond to the thin flexible enclosure substantially sealed around one noise producing component, as recited in claim 1.

Claim 1 also recites that the thin flexible enclosure is sealed to the at least one noise producing component at at least one location. The inner layer 16 of Miller is attached to the interior surfaces of the outer layer 14, but is not sealed at at least one location to any noise producing component, such as the compressor 12.

Claims 2, 4-7 and 10 recite additional features and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein.

Claim 9 recites a method of assembling an apparatus for supplying breathable gas. The method comprises providing at least one noise producing component in a sub-assembly, placing the sub-assembly into the interior of the flexible enclosure through an opening therein, substantially sealing or closing the opening, and subsequently, placing the flexible enclosure within an external housing.

With respect to claim 9, the Office Action on page 2, paragraph number 4, states that the recitation "for supplying breathable gas" has not been given patentable weight because the recitation occurs in the preamble and the preamble is not generally accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the

process steps or structural limitations are able to stand alone. The Office Action cites In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 88 USPQ 478 (CCPA 1951).

M.P.E.P. §2144.04 states:

If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

It is respectfully submitted that the facts involved in the two decisions cited by the examiner are not sufficiently similar to the instant application to permit the examiner to rely on the rationale used by the court.

The case of In re Hirao involved a claim directed to a process for preparing foods and drinks sweetened mildly, which comprised adding specified ingredients under certain conditions to straight chain amylose and subjecting the resulting amylose to the action of a specified amylase and purifying and drying to obtain high purity maltose in crystalline powder form, and then adding the high purity crystalline maltose powder to foods and drinks as the essential added sweetener.

The Patent Office Solicitor argued that the preamble of Hirao's claim recites "a process for preparing food and drinks sweetened mildly, as showing that the subject matter as a whole involves the use of an old sweetening agent in a very obvious manner." The court, however, found that the preamble merely recites the purpose of the process and the remainder of the claim does not depend on the preamble for completeness, and the process steps were able to stand alone. The court rejected the Solicitor's interpretation of the preamble as such an interpretation would improperly broaden the scope of the claim.

On the other hand, as noted on page 11 of the January 17, 2007 response, Applicant respectfully submits that the first step of claim 9 of “assembling an apparatus for supplying breathable gas” is part of the method which the examiner must consider and may not ignore merely because it occurs in the preamble of the claim. In other words, the recitation of “assembling an apparatus for supplying breathable gas” does not merely recite the purpose of the process of claim 9. Giving weight to this recitation is necessary to breathe life and meaning into the claim. See, for example, M.P.E.P. §2111.02, which states:

If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is “necessary to give life, meaning, and vitality” to the claim, then the claim preamble should be construed as if in the balance of the claim.

See also M.P.E.P. §2111.02 II, which states:

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use “can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”

In Kropa v. Robie, the court was faced with the issue of whether the words “An abrasive article” were essential to point out the invention defined by the counts in an interference proceeding. In the court’s judgment, those introductory words gave life and meaning to the counts, for it was only by that phrase that it could be known that the subject matter defined by the claims is comprised as an abrasive article.

Similarly, only by giving weight to the “preamble” of claim 9 can it be known that the subject matter defined by claim 9 is a method of assembling an apparatus for supplying

breathable gas. Accordingly, the examiner's refusal to give this recitation of claim 9 patentable weight is in error.

Moreover, as noted on pages 11-12 of the response filed January 17, 2007, Miller discloses that the compressor 12 is placed into contact with the inner layer 16 which has previously been adhered to or otherwise affixed to the outer layer 14. Therefore, any "opening" of the inner layer 16 cannot be sealed or closed before placing the flexible enclosure (with a noise producing component) within an external housing. Thus, Miller does not disclose or suggest substantially sealing or closing the opening (with the noise producing component sub-assembly therein), and subsequently placing the flexible enclosure within an external housing. As Miller does not disclose or suggest the identical invention recited in claim 9, Miller cannot anticipate or render obvious the claim.

Claim 27 recites an apparatus for supplying breathable gas including a relatively rigid external housing including at least one compartment, an electric motor provided at least partially within the at least one compartment, and a noise suppressing member consisting essentially of a thin flexible enclosure provided to the electric motor.

Miller cannot anticipate claim 27 as Miller does not disclose, at least, an electric motor provided at least partially within at least one compartment of a relatively rigid external housing. As discussed above, there is nothing in the disclosure of Miller that supports the conclusion that the compressor 12 necessarily includes an electric motor provided at least partially within at least one compartment, nor has the examiner provided any basis in fact and/or technical reasoning to support such a finding.

As also discussed above, Miller does not disclose or suggest a thin flexible enclosure as recited in claim 27. The inner layer 16 of Miller is adhered to the relatively rigid outer layer 14.

Claims 28-30 recite additional features and are allowable for the same reasons discussed above with respect to claim 27 and for the additional features recited therein.

Claim 28 recites that the flexible enclosure is bag-like. It is respectfully submitted that it is clear that the inner layer 16 of Miller is not a bag-like enclosure.

With respect to claim 29, as discussed above, it is respectfully submitted that the examiner has failed to provide substantial evidence support for the conclusion that Miller discloses at least one muffler within an enclosure.

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) over Miller are respectfully requested.

Claims 3, 8 and 11-26 were rejected under 35 U.S.C. § 103(a) over Miller. The rejection is respectfully traversed.

With respect to claims 3, 12 and 20, the Office Action on page 4, paragraph number 7, acknowledges that Miller does not disclose or suggest the materials recited in the claims, but concludes that it would have been obvious to use the claimed materials as a matter of obvious design choice. The examiner cites the decision of In re Leshin, 277 F.2d 197, 125 USPQ 416 (CCPA 1960).

As discussed above, Miller discloses that the inner layer 16 is preferably constructed of fiberglass or other flexible and suitably sound absorbent material, but can also be constructed from conventional molded plastic foam material such as, for example, polyurethane.

Firstly, it is respectfully noted that the examiner has not provided any substantial evidence in support of the conclusion that Cosmothene F221-I or polyethylene are materials known to have sound absorbent properties. Accordingly, the examiner's conclusion that one of

ordinary skill in the art would have selected these materials as suitable for the purpose of absorbing sound is without foundation.

Secondly, it is respectfully submitted that the examiner's reliance on the rationale used by the court in In re Leshin fails to cure the deficiencies in the examiner's *prima facie* case of obviousness. The facts of that decision are not sufficiently similar to the instant application to permit the examiner to rely upon the rationale used by the court.

In the case of In re Leshin, the Applicant conceded that the plastics he used were well known but argued that "Applicant has had to select them for his particular purpose." Id. at 199. In the instant application, however, Applicant has not selected the materials recited in claims 3, 12 and 20 because they "had to." As the facts of In re Leshin are not substantially similar to the instant application, the examiner is not permitted to rely on the rationale used by the court in determining the obviousness of claims 3, 12 and 20.

With respect to claims 8, 11 and 13-17, the Office Action on page 4, paragraph number 8, states that "Miller teaches a compressor. Compressors are well known to be powered by electricity supplied by an electrical cord. Therefore it would have been obvious to one having ordinary skill in the art to supply the plastic enclosure of Miller with some type of hole or aperture to allow a power cord to supply power to the device within the enclosure."

As discussed above, the examiner has not provided any substantial evidence to support the conclusion that Miller discloses an electric motor and/or other electrical components. The examiner has also not satisfied the requirements for establishing that Miller inherently includes an electric motor and/or other electrical components. Furthermore, the examiner has not provided any documentary evidence, as requested by Applicant that establishes that compressors are well known to be powered by electricity supplied by an electrical cord. The failure of the

examiner to resolve the factual question of the scope and content of the prior art dictates that the examiner's conclusion that claims 8, 11 and 13-17 are obvious as a matter of law is improper.

As also discussed above, there is no disclosure or suggestion by Miller that the compressor is an apparatus for supplying breathable gas.

Claim 18 recites an apparatus for supplying breathable gas including a relatively rigid external housing, at least one noise producing component internal to the housing, and a thin flexible enclosure provided for the at least one noise producing component, the enclosure being substantially independent of the external housing.

With respect to claim 18, the Office Action on page 4, paragraph number 9, alleges that although Miller does not disclose the enclosure being substantially independent of the external housing, it would have been obvious to make the enclosure substantially independent, since it has been held that constructing a formally integral structure in various elements involves only routine skill in the art. The examiner cites Nerwin v. Erlichman, 168 USPQ 177 (BPAI 1969) in support of this determination.

It is respectfully noted that Miller teaches away from flexible enclosures in column 1, lines 21-52. Miller discloses that prior art patents which disclose highly flexible, laminate, blanket-like covers adapted for wrapping about the body of a pneumatic tool are not sufficiently rigid to retain a given shape separate and apart from the tool body about which they are to be wrapped. Miller also discloses that the wrapping of such a highly flexible sound absorbent cover about the machinery is cumbersome.

It is also respectfully noted that Miller discloses that the inner layer 16, which the examiner alleges corresponds to the thin flexible enclosure, is attached to the outer layer 14 by

glue, pressure sensitive adhesive, or the like. In other words, Miller clearly discloses that the inner layer 16 is substantially dependent, not independent, of the outer layer 14.

The examiner's reliance on the rationale used by the court in Nerwin v. Erlichman is not sufficient to present a *prima facie* case of obviousness. The facts of that decision are not sufficiently similar to the instant application to permit the examiner to rely on the rationale used by the court.

Erlichman, the senior party in interference, recited in Count 1 the limitations 1) a divider between said exposure and processing chamber and 2) means effective upon movement of said strip along said first path for denoting the leading edge of each said sheet along a second path branching from said first path into said exposure chamber.

Nerwin, the junior party, alleged that the two limitations set forth in Count 1 were two separate elements, but that in Erlichman's disclosure these two elements found support only in a structure that was a single element and that Erlichman may not use this single element to meet two positively stated and separately claimed elements of the count. The court rejected Nerwin's argument and found that the mere fact that a given structure is integral does not preclude its consisting of various elements.

There is nothing in the rationale used by the court that would lead one of ordinary skill in the art to the conclusion that it is *prima facie* obvious to construct a formally integral structure in various elements. Moreover, as discussed above, Miller discloses that the inner layer 16 is attached to the outer layer 14 by glue or pressure sensitive adhesive, thus integrating the structures of the inner layer 16 and the outer layer 14. Therefore, Miller teaches directly away from forming the inner layer 16 independent of the outer layer 14.

With respect to claims 21 and 22, the examiner's conclusion that the shape of the enclosure is a mere design choice and that any shape would perform equally well is incorrect. The examiner's conclusion that Applicant has not disclosed that the specific type of shape solves any stated problems or is for any particular purpose is also incorrect. It is also respectfully submitted that although Applicant is not required to disclose these considerations, it is respectfully submitted that Applicant has done so.

With respect to the examiner's conclusion that it appears that the invention would perform equally well with the shape taught by Miller, it is respectfully submitted that the examiner is in error. The issue to be determined in the analysis required by 35 U.S.C. §103(a) is not whether it would have been obvious to modify the claimed invention to perform in a manner similar to the prior art, but whether it would have been obvious to modify, or combine, the prior art to arrive at the claimed invention.

With respect to claim 24, as noted in the response filed January 17, 2007, the examiner alleges that it is well known in the art of compressors that the pressure of air exiting the compressor is adjustable included with the claimed range, but does not present any substantial evidence support that the claimed range is disclosed or suggested by Miller, or any other prior art of record. Furthermore, the examiner does not provide any reasoning as to why one of ordinary skill in the art would operate the compressor of Miller at the pressures of the claimed range.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) over Miller are respectfully requested.

In view of the above amendments and remarks, Applicant respectfully submits that all the claims are patentable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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